Second Preliminary Amendment Attorney Docket: MVA1001USC8
Applicants: Rudy Mazzocchi et al.
Serial No.: 10/607,328

REMARKS

Claim 14 has been amended. New claims 16 to 23 have been added. Support for the amendment and new claims can be found generally throughout the specification and drawing figures. No new matter is added. Claims 5 to 7, 9, and 11 to 23 will be pending and under examination after entry of this amendment.

The Examiner has rejected claims 5 to 7, 9, and 11 to 15 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 4,425,908 (Simon) in view of U.S. Patent No. 5,556,389 (Liprie). Applicants respectfully traverse this rejection.

The Examiner states that Simon in FIGS. 1 to 12 shows guidewire 80, self-expanding nitinol filter 10 associated with guidewire 80, and sheath 58 as recited in the claims. The Examiner states that Simon does not explicitly disclose using an expandable balloon to treat a stenosis site. The Examiner states, however, that it is well known in the art to treat an occlusion/stenosis/restriction by expanding a balloon and refers to Liprie (FIGS. 1 to 5) as showing guidewire 16 for guiding balloon 18 to treat a stenosis 30. The Examiner concludes that in view of Liprie it would have been obvious to one of ordinary skill in the art at the time of the invention to use a balloon catheter to follow a guidewire 80 of Simon to treat a stenosis as recited in the claims. The Applicants disagree.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive that would motivate a person of ordinary skill in the art to make the combination. As applied to these claims there is no such motivation. Simon discloses a filter for use in the vena cava for filtering blood clots and thus preventing pulmonary embolism. The filter is meant to be left in the vena cava permanently. The guidewire is a separate component with a tip which butts against a thrust-bearing surface of the filter. Once the filter is deployed the guidewire is removed. Simon

discloses no structure or method for removing the filter and in view of the structure of the filter there is no obvious way to remove it. Applicants submit it would not be obvious nor even desirable to combine the permanent blood clot filter and guidewire of Simon with the balloon catheter of Liprie. Even if the combination were possible it would require leaving the filter in the vessel after treatment of the stenosis.

Further, even if one were motivated to combine the filter and guidewire of Simon with the catheter of Liprie that combination would not result in the invention of Applicant's claims. Claim 5 requires "advancing a treatment catheter over the guidewire to position the treatment catheter at the treatment site." Claim 12 is directed to a system having a guidewire and an expandable filter associated with a distal region of the guidewire and a catheter having a treatment device and a lumen which slidably receives the guidewire. As described in Simon guidewire 80 is always associated with at least guide wire feeder 66 and storage tube 50 which, along with catheter 58, are withdrawn as a unit after the filter is deployed. Additionally, guidewire feeder 66 and storage tube 50 encumber the proximal end of the guidewire such that a treatment catheter cannot be loaded onto the proximal end of the guidewire. At no time during the implantation procedure described in Simon is the guidewire in place in the vessel in a condition whereby a treatment catheter could be advanced over or receive the guidewire as required by the claims.

Based on the foregoing Applicants submit that claims 5 to 7, 9, and 11 to 15 are not obvious over Simon in view of Liprie and respectfully request that the rejection be withdrawn. New claims 16 to 23 depend from either claim 5 or 12 and add further limitations. These claims are allowable for at least the reasons set forth above.

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Respectfully submitted,

Date: 4/23/07

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